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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

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Application Number: 09/132,351
Filing Date: August 12, 1998
Appellant(s): Roe-Kwan Kim

Paul J. Farrell
For Appellant

EXAMINER'S ANSWER

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This is in response to appellant's brief on appeal filed May 25, 2001.

(1)Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3)Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4)Status of Amendments After Final

No amendment after final has been filed.

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(5)Summary of Invention

The summary of invention contained in the brief is correct.

(6)Issues

The appellant's statement of the issues in the brief is correct.

(7)Grouping of Claims

The rejection of claims 1, 2-10, 13 and 14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8)Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal:

6,026,296 SANDERS, III ET AL 2-2000

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(10)Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371[©] of this title before the invention thereof by the applicant for patent.

2. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Sanders, III et al (Sanders), U.S. Patent No. 6,026,296.

Regarding claim 1, Sanders discloses a method for transmitting a short message to a plurality of subscribers in a mobile communication system (col. 7, lines 4-20; figures 1 and 6), comprising the steps of:

- registering a plurality of called subscriber numbers in a short message service center of said mobile communication system by associating each of said plurality of called subscriber numbers with a group identifier, the group identifier being a separately defined field (col. 2, lines 37-65 and col. 7, lines 4-20); and

- simultaneously transmitting said short message to each of said plurality of called subscriber numbers by designating said group identifier (col. 10, lines 17-41).

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Regarding claim 9, Sanders discloses a method for transmitting a short message to a plurality of subscribers in a mobile communication system (col. 7, lines 4-20), comprising the steps of:

- transmitting from a mobile communication terminal a short message registration signal including a short message service center number, a group identifier and at least one subscriber number, the group identifier being a separately defined field (col. 10, lines 17-41);
- detecting, by a short message service center, said group identifier from said short message registration signal (col. 10, lines 17-41); and
- registering said transmitted subscriber numbers in said short message service center in accordance with said detected group identifier (col. 2, lines 37-65 and col. 7, lines 4-20).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 7, 8, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders, III et al (Sanders), U.S. Patent No. 6,026,296 and Huotari, U.S. Patent No. 5,987,323.

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Regarding claim 2, Sanders discloses in a mobile communication system having a plurality of base station subsystems for demodulating signals received from a plurality of corresponding mobile communication terminals and a mobile switching center, operatively connected to said plurality of base station subsystems, for detecting a short message service center number from said demodulated signals and for switching to a corresponding short message service center through a gateway, a method for transmitting a short message to a plurality of subscribers (figure 1), comprising the steps of:

- transmitting short message information from one of said mobile communication terminals, said short message information including a group identifier and a short message, the group identifier being a separately defined field (col. 10, lines 17-41);
- detecting, by said short message service center, said group identifier from said short message information (col. 10, lines 17-41); and
- simultaneously transmitting said short message to subscriber numbers associated with said detected group identifier (col. 10, lines 17-41 and col. 10, lines 44-52).

Sanders, however, fails to specifically disclose wherein the short message service center has a memory.

Huotari discloses a short message service center having a memory (col. 3, lines 26-39).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Sanders with the teachings of Huotari for the purpose of having the capability to store short messages when the desired mobiles are not reachable (Huotari, col. 3, lines 26-30).

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Regarding claim 7, the combination of Sanders and Huotari discloses the method of claim 2, and further discloses wherein said step of detecting the group identifier from said short message information includes the substeps of:

- determining if said short message information is received (Sanders, col. 10, lines 31-41);
- determining if said short message information is a group transmission mode or a normal short message mode when said short message information is received (Sanders, col. 10, lines 21-41);
- detecting said short message from said short message information (Sanders, col. 10, lines 21-41); and
- detecting said group identifier from said short message information (Sanders, col. 10, lines 21-41).
- storing said short message (Huotari, col. 3, lines 26-30).

Even though the Huotari uses a single subscriber in which a message can be stored for, and not a group of subscribers, it would have been obvious to a person of ordinary skill in the art at the time of invention to combine the teachings of Sanders (e.g. group communication, col. 9, lines 20-35 and col. 10, lines 17-41), with the teachings of Huotari for the purpose of being able to retransmit the SMS message at a later time if the SMS message is unable to be reached by the targeted subscribers.

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Regarding claim 8, the combination of Sanders and Huotari discloses the method of claim 2, and further discloses wherein said step of simultaneously transmitting said short message includes the substeps of:

- determining if said detected group identifier exists in said memory of said short message service center (Sanders, col. 8, lines 39-55 and Huotari, col. 3, lines 26-30);
- reading from said memory subscriber numbers corresponding to said detected group identifier if the detected group identifier exists in said memory (Sanders, col. 8, lines 39-55 and Huotari, col. 3, lines 26-30); and
- dialing (inherent as evidenced by the fact that the subscribers , e.g. target communication devices, were transmitted the short message) said subscriber numbers read from said memory to transmit said short message thereto (Sanders, col. 10, lines 28-40 and Huotari, col. 3, lines 26-30).

Regarding claim 13, Sanders discloses the method of claim 9 as described above.

Sanders however, fails to specifically disclose storing the group identifier from the short message registration signal.

Huotari discloses a method wherein an SMS center can store messages directed to mobiles when the mobiles are not reachable (col. 3, lines 26-30)

Regarding storing the group identifier in a memory of the SMS center, the examiner contends that this limitation is an engineering decision predicated on need performance, and therefore, at the time of invention, it would have been obvious to a person of ordinary skill in

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the art to implement this limitation for the purpose of needing to recall the group identifier in the instance where the SMS message had to be transmitted by the SMS center at a later time if the terminating mobile was not reachable as taught by Huotari (col. 3, lines 26-30).

Regarding claim 14, Sanders discloses the method of claim 9 as described above, and further discloses wherein said step of registering said transmitted subscriber numbers comprises the step of detecting said transmitted subscriber numbers (col. 10, lines 17-41).

Sanders, however, fails to specifically disclose assigning a plurality of addresses corresponding to the detected group identifier; and storing each of said subscriber numbers in a corresponding one of said addresses.

Huotari discloses a method wherein an SMS center can inherently assign an address for an SMS message as evidenced by the fact that the center can store an SMS message directed to a terminating mobile if that mobile is not able to be reached (col. 3, lines 26-30).

Even though the Huotari uses a single subscriber in which a message can be stored for, and not a group of subscribers, it would have been obvious to a person of ordinary skill in the art at the time of invention to combine the teachings of Sanders (e.g. group communication, col. 9, lines 20-35 and col. 10, lines 17-41), with the teachings of Huotari for the purpose of being able to retransmit the SMS message at a later time if the SMS message is unable to be reached by the targeted subscribers.

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5. Claims 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders, III et al (Sanders), U.S. Patent No. 6,026,296 and Huotari, U.S. Patent No. 5,987,323 as applied to claim above, and further in view of applicant's own admission.

Regarding claim 3, the combination of Sanders and Huotari discloses the method of claim 2 as described above, and further discloses a method wherein a user can press a button on their mobile phone to send a short message to a group of target users (Sanders, col. 10, lines 42-52).

The combination, however, fails to specifically disclose the method wherein the step of transmitting the short message information from said mobile communication terminal includes the steps of:

- displaying a plurality of menus;
- selecting a short message service menu from said plurality of displayed menus;
- displaying a first set of sub-menus associated with said short message service menu, said first set of sub-menus including a short message transmission mode and a short message group registration mode sub-menu;
- instructing a calling subscriber to input a short message service center number in response to selecting said short message transmission mode sub-menu;
- displaying a second set of sub-menus associated with said short message transmission mode, said second set of sub-menus including a group transmission mode and a normal transmission mode sub-menu;

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- inputting said group identifier and said short message if said group transmission mode is selected; and
- transmitting a short message signal including said short message center number, said group identifier and said short message.

However, the applicant has provided a conventional short message transmission operation which meets the limitations of claim 3 (page 4, lines 6-18).

Even though the applicant's admitted prior art uses a single transmission mode, and not a group transmission mode, it would have been obvious to a person of ordinary skill in the art at the time of invention to combine the teachings of Sanders (e.g. group transmission, col. 10, lines 17-41), and Huotari with the teachings of the admitted prior art for the purpose of being able to send a short message to a group of subscribers at one time.

Regarding claim 4, the combination of Sanders, Huotari, and admitted prior art discloses the method of claim 3, and further discloses wherein said short message signal is transmitted by actuating a transmit key of said mobile communication terminal (Sanders, col. 10, lines 44-52 and applicant, page 4, lines 15-18).

Regarding claim 6, the combination of Sanders, Huotari, and admitted prior art discloses the method of claim 3, and further discloses wherein said plurality of menus are displayed by actuating a menu key of said mobile communication terminal (applicant, page 4, lines 6-9).

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6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders, III et al (Sanders), U.S. Patent No. 6,026,296, and applicant's own admission as applied to claim 3 above, and further in view of Alanara et al (Alanara), U.S. Patent No. 5,878,351.

Regarding claim 5, the combination of Sanders and applicant's own admission discloses the method of claim 3, and further discloses wherein said step of inputting said group identifier and said short message includes the substeps of:

- instructing a calling subscriber to input an identifier (applicant, page 4, lines 6-18);
- determining if the identifier is input (applicant, page 4, lines 6-18);
- instructing said calling subscriber to input said short message (applicant, page 4, lines 6-18); and
- determining if a short message end signal is input (applicant, page 4, lines 6-18).

The combination, however, fails to specifically disclose storing the short message in the memory of said mobile communication terminal if said short message end signal is input, and also fails to disclose storing said input group identifier in a memory of said mobile communication terminal.

Alanara discloses storing a short message in the memory of a mobile communication terminal if a short message end signal is input (col. 6, line 56-col. 7, line 6).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Sanders and the applicant's own admission with the teachings of Alanara for the purpose of having the capability to retransmit the user originated SMS

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message at a later time if the SMS message is unable to be transmitted (Alanara, col. 6, line 63-col. 7, line 1).

Regarding storing the input group identifier in a memory of the mobile communication terminal, the examiner contends that this limitation is an engineering decision predicated on need performance, and therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to implement this limitation for the purpose of needing to recall the group identifier in the instance where the SMS message had to be retransmitted by the originating user at a later time as taught by Alanara described above.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders, III et al (Sanders), U.S. Patent No. 6,026,296 and applicant's own admission.

Regarding claim 10, Sanders discloses the method of claim 9 as described above.

Sanders, however, fails to specifically disclose wherein said step of transmitting said short message registration signal comprises the steps of:

- displaying a plurality of menus;
 - selecting a short message service menu from said plurality of displayed menus;
 - displaying a first set of sub-menus associated with said short message service menu,
- said first set of sub-menus including a short message transmission mode and a short message group registration mode;

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- instructing a calling subscriber to input a short message service center number in response to selecting said short message group registration mode sub-menu;
- inputting said group identifier and said subscriber numbers; and
- transmitting said short message signal including said short message service center number, said group identifier and said subscriber numbers.

However, the applicant has provided a conventional short message transmission operation which meets the limitations of claim 3 (page 4, lines 6-18).

Even though the applicant's admitted prior art uses a single transmission mode, and not a group transmission mode, it would have been obvious to a person of ordinary skill in the art at the time of invention to combine the teachings of Sanders (e.g. group transmission, col. 10, lines 17-41) with the teachings of the admitted prior art for the purpose of being able to send a short message to a group of subscribers at one time.

Allowable Subject Matter

8. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: Prior art fails to suggest or render obvious the limitation of claim 11 determining if a

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subscriber number end key is actuated; and instructing a caller to input another desired subscriber number if said subscriber number end key is not actuated.”

10. Claim 12 is dependent on objected claim 11, and would be allowable solely as a result of its dependence from claim 11.

(11)Response to Argument

Appellant argues that Sanders fails to disclose a group identifier that is a separately defined field, rather, discloses directing messages to a single pre-defined dispatch group based on a characteristic of the transmitting device.

At the outset, it was noted that the appellant did not associate the group ID field to the transmitted short message. Thus, the broadest reasonable interpretation of this limitation requires that there be a group ID field somewhere within the communication system. This is how the examiner interpreted the claim limitations.

The examiner asserted that Sanders does disclose a telecommunication system in which a communication device sends, along with its ID, the short message (SMS) that is to be transmitted. The communication device's ID is then associated with the other members of a talk group. The examiner maintains that Sanders teaches that when an originating communication device desires to initiate a dispatch call or a group call, the communication device transmits its ID to a dispatch controller then associates the transmitted ID with specific talk group members by

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retrieving dispatch related information from a database (see Sanders, col. 2, lines 48-56 and col. 10, lines 21-32).

Given the fact that there is a talk group affiliation in the system of Sanders as admitted by the appellant on page 5, paragraph 3, line 7 of their brief, and that an association is made absent specific information concerning a group other than the communication device's own ID, then inherently there is a separately defined field in the system that identifies all of the members of the targeted talk group.

Therefore, given that the claim language merely requires a group identifier that is a separately defined field somewhere in the communication system; given that it has been demonstrated how the Sanders reference meets this limitation; and given that this is the sole point of argument in appellant's brief regarding all appealed claims; it is requested that the rejections be sustained.

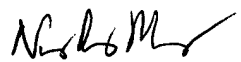

Respectfully submitted,

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